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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/801,138	03/06/2001	Robert Olan Keith JR.	ABREAU-00102	6011

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HAVERSTOCK & OWENS LLP  
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EXAMINER

NGUYEN, CAM LINH T

ART UNIT	PAPER NUMBER
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2171

DATE MAILED: 10/22/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

09/801,138

Applicant(s)

KEITH, ROBERT OLAN

Examiner

Cam-Linh T. Nguyen

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 September 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-96 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-96 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### Response to Amendment

1. Applicant's amendments to the specification are acknowledged. Consequently, rejection to the specification is withdrawn.

### ***Double Patenting***

1. Claims 1 - 96 of this application conflict with claims 1 - 40 of Application No. 09/801,072. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.
2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claims 1 – 96 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1 - 40 of copending Application No. 09/801,072. This

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is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

The following table shows the claims in '138 that are rejected by corresponding claims in '072

Claims comparison table

	'138	'072
Claims	1, 2, 49, 50, 73, 74	1, 36, 37,
	3, 53, 78	5
	4, 54, 75	2
	5, 51, 76	3
	6, 52, 77	4
	7, 55, 79	6, 39,
	8, 56, 80	7
	9, 57, 81	8, 38
	10, 58, 82	9
	11, 59, 83	10, 40,
	12, 60, 84	11
	13, 61, 85	12
	14, 62, 86	13
	15, 16, 39, 40, 63, 64, 87, 88	27
	17, 41, 65, 89	28
	18, 42, 66, 90	29

19, 43, 67, 91	30
20, 44, 68, 92	31
21, 45, 69, 93	32
22, 46, 70, 94	33
23, 47, 71, 95	34
24, 48, 72, 96	35
25 & 26	14
27	17
28	18
30	16
31	19
32	20
33	21
34	22
35	23
36	24
37	25
38	26
39 & 40	14 & 27
48	35

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 4 – 5, 7 – 15, 17 – 25, 29 – 39, 41 – 51, 54 – 76, 79 – 96, are rejected under 35 U.S.C. 102(e) as being anticipated by Snow et al (U.S. 6,098,066).

♦ As per claim 1, 15, 25, 39, 49, 63, 73, 87,

Snow teaches a method of performing a research task within a searchable database comprising:

- “Utilizing a selective one or more search methodologies including keyword search, hierarchical search...” See Fig. 2, element 30, where “terms command” is corresponding to “keyword search”. The “searchable database” is corresponding to the “class hierarchy directory database 10 (Fig. 1, col. 3 line 11 – 12). Depending on the search criteria, the matching item can be located in different node category. The matching item in a particular node or sub node is corresponding to “a segment of the searchable database”.
- “A subsequent search” corresponds to a second or third loop of search based on the result (See Fig. 2, col. 4 line 11 – 24, Fig. 7, col. 7 line 61 - 66). When a second loop is performed, the result is a “sub-segment” of the previous result.

♦ As per claim 4, 29, 54, 74 – 75, 88,

- "The search criteria is one or more keywords input by a user" See Fig. 2, where terms command includes plurality of keywords.
- ◆ As per claim 5, 30, 50 – 51, 64, 76,
  - "The utilized search methodology is the hierarchical search, the search criteria is selected one of a list of one or more directory items" See Fig. 2 elements 2, 26, col. 4 line 4 - 24. The category command corresponds to the hierarchical search because it creates the class hierarchy.
- ◆ As per claim 7, 20, 31, 44, 55, 68, 79, 92,
  - "The searchable database is distributed into more than one physical location" See Fig. 9, col. 9 line 6 – 16.
- ◆ As per claim 8 – 10, 17 – 19, 32 – 34, 41 – 43, 56 – 58, 65 – 67, 80 – 82, 89 – 91,

The computer network 142, element 140 in Fig. 9 corresponds to the server. The transmission line 144 corresponds to the "Internet connection", and the system in Fig. 9 is a client-server computer.
- ◆ As per claim 11 – 12, 21 – 22, 35 – 36, 45 – 46, 59 – 60, 69 – 70, 83 – 84, 93 – 94,
  - "The searchable database is formatted in a directory tree structure" See Fig. 1, col. 2 line 62 – 67.
  - "The directory tree structure includes nodes ... branches" see fig. 1, element 12.
  - Because the category includes documents, thereby, it must include text or graphics when display to users.
- ◆ As per claim 13 – 14, 23 – 24, 37 – 38, 47 – 48, 61 – 62, 71 – 72, 85 – 86, 95 – 96,

- "Maintaining the node by appropriately adding and deleting data to and from the node" See fig. 3; col. 4 line 25 – 40.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2 – 3, 6, 16, 26 – 28, 40, 52 – 53, 77 – 78, are rejected under 35 U.S.C. 103(a) as being unpatentable over Snow et al (U.S. 6,098,066) in view of Danish et al (U.S. 6,327,588).

♦ As per claim 2 – 3, 6, 16, 26 – 28, 40, 52 – 53, 77 – 78,

As discussed above, Snow teaches about the keyword search, and hierarchical search. Snow does not clearly teach about the parametric search and dichotomous key search. However, in the same field of retrieving data from a searchable database, Danish et al (U.S. 6,327,588), discloses a method for searching documents using parametric search and dichotomous key search. Danish teaches that a user can use parametric search to identifying matching items (See the abstract, Danish). Further, Danish gives the user the opportunities to select some options that available to the user (See Fig. 8). The values of the parameters could be "binary values" that can turn the search options on/off or yes/no values. This search method is corresponding to the "dichotomous key search". Danish teaching also is in the same field with Snow teaching. It would have been obvious to one with ordinary skill in the art at the time the



invention was made to apply the teaching of Danish to the system of Snow, because the combination of two systems provides the user more flexibility, widen the field of search for a document in a searchable database (col. 3, line 27 – 35, Danish).

### ***Response to Arguments***

2. Applicant's arguments filed 09/29/2003 have been fully considered but they are not persuasive.

♦ Applicant argues that the Snow reference fails to disclose the limitation of searching the documents for specific values of predetermined parameters (page 4 of the amendment), and a dichotomous key search (page 5). The Examiner respectfully disagrees.

Applicant claims this limitation in claim 1 as: "...**selective one or more search...**" Therefore, the Snow reference still applies to the claimed language by selecting one method of searching such as key word searching.

♦ Applicant argues that the Snow reference fails to disclose a dichotomous key search. The Examiner respectfully disagrees.

Specifically, the Examiner does not use the Snow reference to teach the dichotomous key search. Instead, the Examiner provides the teaching of Danish for the dichotomous key search, which was then applied to the system of Snow.

### ***Conclusion***

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cam-Linh T. Nguyen whose telephone number is 703-305- 1951. The examiner can normally be reached on Monday - Friday from 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on (703) 308- 1436. The fax phone number for the organization where this application or proceeding is assigned is 703- 746- 7239. A new official fax number, that will effect in December 1<sup>st</sup>, 2003, is 703 -872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703- 305- 3900.

Cam-Linh Nguyen  
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